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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,425	03/29/2001	Sci-Yu Chen	DEX-0203	2890

26259 7590 12/31/2002

LICATLA & TYRRELL P.C.
66 E. MAIN STREET
MARLTON, NJ 08053

EXAMINER

YU, MISOOK

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 12/31/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,425

Applicant(s)

CHEN ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

The Examiner of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Misook Yu.

Election/Restrictions

Upon review and reconsideration, re-restriction to one of the following inventions is required under 35 U.S.C. 121:

1-12. Claims 1-6 and 9, drawn to a polynucleotide, oligonucleotide, vector, host
Group 12 cell, and a method of making a protein, classified in class 536, subclass

w/ SEQ ID
12 elected
23.1. **Each SEQ ID is a different invention.**

13-24. Claims 7, 9, and 23, drawn to a polypeptide, classified in class 530, subclass 350. Each polypeptide encoded by each SEQ ID NO of group 1-12 is different invention.

25-36. Claim 8, drawn to an antibody, classified in class 530, subclass 387.1. Antibody specific for each of polypeptides in groups 15-36 is different invention

37-48. Claims 10-14, drawn to a method of diagnosing the presence and metastases of lung cancer and staging and monitoring lung cancer by determining the level of each of the polypeptides in groups 13-24 above, classified in class 435, subclass 7.1. Each

49-60. Claim 15, drawn to a method of identifying potential therapeutic agents for imaging and treating lung cancer by screening molecules capable of binding a polypeptide of groups 13-24 above, classified in class 424, subclass 9.341 and 134.1.

61-72. Claims 16-17, drawn to a method of imaging lung cancer using an antibody of groups 25-36 above, classified in class 424, subclass 9.341.

73-84. Claims 18-19, drawn to a method of treating lung cancer with an antibody groups 25-36 above, classified in class 424, subclass 178.1.

- 85-96. Claims 20 and 22, drawn to a method of identifying compound, which antagonize a LSG polypeptide of groups 13-24, classified in class 424, subclass 184.1.
- 97-108. Claims 20 and 21, drawn to a method of identifying compound which agonize a LSG polypeptide of groups 13-24, classified in class 424, subclass 184.1.
- 109-110. Claim 24, drawn to a method of inducing an immune response against a polypeptide of groups 13-14, classified in class 514, subclass 2.
- 111-122. Claim 25, drawn to a method of treating lung cancer with a vaccine comprising each of protein in groups 13-24 above, classified in class 424, subclass 185.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions 13-24 (product) and 37-48, 49-60, 85-96, 97-108, 109-110 (methods) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process 37-48, 49-60, 84-96, 97-108, or 109-110.

The products of Groups 1-36 are drawn to structurally and functionally different molecules with different biological properties, modes of action, half-life, and target different receptors.

Inventions 25-36 (product) and 61-72, 73-84 (methods) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process 61-72 or 73-84.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, divergent subject matter, and require different search strategies, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Applicant is advised that the response to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu
December 30, 2002


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600